



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/683,426	12/27/2001	George Brookner	ASCO.P-070	8729

21121 7590 05/06/2003

OPPEDAHL AND LARSON LLP  
P O BOX 5068  
DILLON, CO 80435-5068

EXAMINER

WOO, RICHARD SUKYOON

ART UNIT PAPER NUMBER

3629

DATE MAILED: 05/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/683,426

Applicant(s)

BROOKNER

Examiner

Richard Woo

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Arguments*

1) Applicant's arguments, filed February 7, 2003, with respect to the rejections as being anticipated by or being unpatentable over the various prior arts as cited by the examiner have been fully considered but are not persuasive.

-- With respect to the rejection under 35 U.S.C. 102 as being anticipated by Ruat, the applicant asserts that Ruat does not specifically disclose the method including a "purchaser" or a "purchase". In response to applicant's arguments, the recitation a "purchaser" or a "purchase" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

The applicant further contends that the applicant is unable to find the limitation, the "precondition", in Ruat. In response to the applicant's argument, the examiner, after diligent review of the English portions of Ruat and drawings, invites the applicant's attention to the abstract, which shows that the coded information (24) not only permit automatic invoicing but also prevents fraudulent acts. In order to prevent fraudulent acts, any information indicative of the purchaser or sender's identity should be received

by any postal service before disseminating postal indicia, i.e. preconditioning of purchasing the indicia.

Regarding limitations (b) and (c) in Claim 1, the applicant argues that Ruat prints various information on a mail piece and there is no indication of printing information indicative of the purchaser upon the indicium. The examiner respectfully disagrees with the applicant. The abstract of Ruat discloses that the coded information, which is printed on the mail piece, comprises data on the sender's (or purchaser in the applicant's term) and addressee's identities (or information indicative of the sender or purchaser).

Regarding limitation (d) in Claim 1, the applicant asserts that Ruat does not show that a mail piece bearing information indicative of the identity of the purchaser (or sender as recited by Ruat). In response to the applicant's argument, the abstract of Ruat shows that the mail piece bears "identities" and "address", i.e. information indicative of the identity of the purchaser (or sender as recited by Ruat).

With respect to other independent claims that are rejected as anticipated by Ruat, the applicant's arguments are deemed to be moot in view of the examiner's response as cited earlier.

-- With respect to the to the rejection under 35 U.S.C. 102 as being anticipated by Windel, the applicant asserts that Windel does not specifically disclose the method including a "purchaser" or a "purchase". In response to applicant's arguments, the recitation a "purchaser" or a "purchase" has not been given patentable weight because the recitation occurs in the preamble, and the applicant's argument is deemed to be

moot in view of the reason as recited earlier. Additionally, Fig. 18 depicts how to generate a data authentication code (DAC), which is an essential part of the information indicative of the vendor (or purchaser in applicant's term). Fig. 18 shows that the vendor's identity and other information indicative of vendor should be entered prior to generate the DAC so that the vendor can print the postal indicia and the postal service can authenticate later on. The database of the central postal service already includes the vendor's (or purchaser's) data, which is submitted by the vendor earlier so that the postal service can compare the authentication code, which is abstracted from the postal indicia on the mail piece, with the counterpart code, which is stored in the database.

-- With respect to dependent claims, the applicant's arguments seem to be moot in view of the examiner's earlier responses regarding the independent claims.

2) The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action

### ***Claim Rejections - 35 USC § 102***

3) Claims 1, 3-4, 7, 9-10, 12-13, 16, 18-20, 22-23, 26 and 28-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Ruat (WO 95/20200).

Ruat discloses a method for use with mail piece, comprising (see generally Figs.):

requiring receipt of first information about a purchaser's identity (to prevent fraudulent acts);

deriving second information from the first information;

printing the second information upon the at least one postal indicium (see Figs. 1-2);

receiving an addressed mail piece with the at least one postal indicium into the mail;

delivering the mail piece;

wherein the postal indicium is a meter strip (see Figs.);

wherein the postal indicium is printed on an envelope (see Figs.);

wherein the second information is a visibly printed bar code (see Figs.);

number of postal indicia comprising a plurality; and

wherein the information about the identity is cryptographically signed (see Figs. and abstract).

4) Claims 1, 3-4, 6-10, 12-13, 15-20, 22-23, 25-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Windel et al. (US 5,953,426).

Windel et al. discloses a method for use with mail piece, comprising (see generally Figs.):

requiring receipt of first information about a purchaser's identity (see Fig. 18);

deriving second information from the first information (see Fig. 18);

printing the second information upon the at least one postal indicium (see Figs. for the various types of indicia);

receiving an addressed mail piece with the at least one postal indicium into the mail;

delivering the mail piece;

Art Unit: 3629

wherein the postal indicium is a meter strip (see Figs.);

wherein the postal indicium is printed on an envelope;

wherein the second information is an invisibly printed bar code (as requested by USPS; see col. 46);

wherein the second information is a visibly printed bar code (see Figs.);

wherein the second information is a human readable message (see Figs.; col. 46);

number of postal indicia comprising a plurality;

wherein the information about the identity is cryptographically signed (see Figs. 18 and abstract); and

inspecting the delivered mail piece when the sender is not on the list of expected senders (by opening the mail piece when the sender is not matched with the database; see the summary of the invention for example).

### ***Claim Rejections - 35 USC § 103***

5) Claims 2, 11, 21 and 33-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ruat in view of Brasington et al. (US 5,923,406).

Ruat discloses the invention as cited earlier, but does not expressly disclose the method and apparatus comprising the postal indicium being an adhesive postage.

Brasington et al. teaches, for a postal stamp machine, that the postal stamp is adhesive (see Figs.).

Since Ruat and Brasington et al. are both from the same field of endeavor, the purpose disclosed by Brasington et al. would have been well recognized in the pertinent art of Ruat.

Accordingly, it would have been obvious at the time the invention was made to a person having ordinary skill in the art, to modify the postal stamp of Ruat such that the postal stamp is printed on the adhesive label, as taught by Brasington et al., for the purpose of attaching the stamp onto the mail piece instead of traditionally moisturizing the stamp to make it adhesive.

6) Claims 2, 11, 21 and 33-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Windel et al. in view of Brasington et al. (US 5,923,406).

Windel et al. discloses the invention as cited earlier, but does not expressively disclose the method and apparatus comprising the postal indicium being an adhesive postage.

Brasington et al. teaches, for a postal stamp machine, that the postal stamp is adhesive (see Figs.).

Since Windel et al. and Brasington et al. are both from the same field of endeavor, the purpose disclosed by Brasington et al. would have been well recognized in the pertinent art of Windel et al..



Accordingly, it would have been obvious at the time the invention was made to a person having ordinary skill in the art, to modify the postal stamp of Windel et al. such that the postal stamp is printed on the adhesive label, as taught by Brasington et al., for the purpose of attaching the stamp onto the mail piece instead of traditionally moisturizing the stamp to make it adhesive.

7) Claims 5, 14 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ruat in view of Kara (US 5,717,597).

Ruat discloses the invention as cited earlier, but does not expressly disclose the postal indicium being printed on a post card.

Kara teaches, for a system and method for printing the postage indicia, that the postage indicia are printed on a post card (see Figs.).

Since Ruat and Kara are both from the same field of endeavor, the purpose disclosed by Kara would have been well recognized in the pertinent art of Ruat.

Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art, to print the postage indicia on the post cards, as taught by Kara, for the purpose of producing the personalized post or greeting cards with custom-made postage indicia.

8) Claims 5, 14 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Windel et al. in view of Kara (US 5,717,597).

Windel et al. discloses the invention as cited earlier, but does not expressively disclose the postal indicium being printed on a post card.

Kara teaches, for a system and method for printing the postage indicia, that the postage indicia are printed on a post card (see Figs.).

Since Windel et al. and Kara are both from the same field of endeavor, the purpose disclosed by Kara would have been well recognized in the pertinent art of Windel et al..

Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art, to print the postage indicia on the post cards, as taught by Kara, for the purpose of producing the personalized post or greeting cards with custom-made postage indicia.

### ***Conclusion***

9) Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

Art Unit: 3629

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard Woo whose telephone number is 703-308-7830. The examiner can normally be reached on Monday-Friday from 8:30 AM -5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703-308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-308-3691 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0861.



Richard Woo  
Patent Examiner  
GAU 3629  
May 02, 2003



JOHN G. WEISS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600